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applications that were cited in the IDS of the present application. The IDSs of the copending applications include copies of the prior art cited in the IDS of the present application that was filed on December 8, 2000. Applicants respectfully request that the original IDS and prior art be examined.

#### Rejection Under 35 USC §112, 2<sup>ND</sup> Paragraph

Claims 1-7 and 10-21 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office states that in claim 1 the phrase "treating the skin" is vague and in claim 4 the "0.2" for the external phase is indefinite because the external phase for this value is smaller than the internal phase. Applicants traverse this rejection.

Applicants respectfully submit that the claims as amended are definite under the second paragraph of §112. First, the phrase "treating the skin" is a term of art that is well known in the beauty care field. This fact is apparent based on the use of similar language in the patent cited in the §103 rejection below. Specifically, US Patent 5494674 discloses a system for delivering skin treatment agents to the skin. Thus, it is clear that this is phraseology that is well understood by those skilled in the art. With regard to the use of "0.2" as the weight ratio of the insulating external phase to the conductive internal phase, one skilled in the art would clearly recognize that is quite possible that the weight of the external phase could be less than that of the internal phase depending on the molecular weights of the materials chosen to make up the respective phases. Thus, it is not uncommon that this type of ratio would be useful in characterizing relative amounts of the phases to one another. Applicants, therefore, earnestly request withdrawal of the rejection of the claims under 35 USC §112, second paragraph and reconsideration of the claims.

#### Rejection Under 35 USC §103

Claims 1-7 and 10-21 stand rejected under 35 USC §103(a) as being unpatentable over Barnett et al. (US Patent 5494674) in view of Masuda (WO 98/26752). The Office states that Barnett teaches an electrostatic spraying system for skin treatment agents while not teaching an emulsion composition containing volatile silicones. Therefore, the Office relies on Masuda as teaching an emulsion composition comprising up to about 90% of volatile silicones as an external phase and up to about 30% of propylene glycol as an internal phase. Based on Masuda's additional teachings of emulsifiers and silicone viscosities under 10,000 cSt, the Office believes that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to deliver the composition of Masuda to achieve the beneficial effect of cost effectiveness, safety, and evenness of coverage on the skin surface during application by using an electrostatic spray in view of Barnett. Applicants traverse this rejection as well.

Barnett discloses a system for delivering skin treatment agents to the skin. More particularly, the disclosed invention relates to methods and apparatus for applying such agents onto the skin using the principle of electrostatic spraying. As indicated by the Office, the reference fails to teach or suggest that

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App's Base  
no argument

emulsion compositions could be electrostatically applied to skin as presently claimed. In fact, the reference teaches away from more complex compositions like emulsions since it teaches that the inclusions of "stabilizing ingredients such as surfactants, polymers, preservatives, etc" could lead to poor sensory property like stickiness, greasiness, or irritation. See, col. 1, lines 26-31 of Barnett. Thus, one skilled in the art who would have read this disclosure would have been led away from arriving at the present invention since the reference teaches that compositions that include more complex constitutions are undesirable.

Masuda does not remedy the shortcoming of Barnett. Rather, Masuda discloses a water-in-oil emulsion foundation wherein the aqueous internal phase comprises: a) from about 0.1 % to about 10 % by weight of the foundation, of a water soluble or dispersible polymer; b) from about 0.5 % to about 30 % by weight of the foundation, of a plasticizing solvent; and c) from about 1 % to about 30 % by weight of the foundation, of an ultra fine titanium dioxide-water dispersion. The ultra fine titanium dioxide-water dispersion comprises from about 0.2 % to about 18 % by weight of the foundation of an ultra fine titanium dioxide, and from about 0.002 % to about 7.2 % by weight of the foundation of a nonionic surfactant. There is no teaching or suggestion found in this secondary reference of the invention that is claimed by Applicants which includes the electrostatic spraying of an emulsion comprising from about 5% to about 75% of an insulating external phase comprising one or more liquid insulating materials and from about 15% to about 80% of a conductive internal phase comprising one or more conductive materials. Applicants, therefore, respectfully assert that a skilled artisan would not have even attempted to arrive at the present invention since Barnett teaches away from emulsion-type or complex compositions being electrostatically sprayed and Masuda discloses nothing that reverses this teaching away. Based on the failed teachings of both references to arrive at the claimed invention, Applicants assert that the rejection of claims 1-7 and 10-21 are improper. Thus, withdrawal of the rejection and reconsideration of the claims is earnestly requested.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Gabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983).

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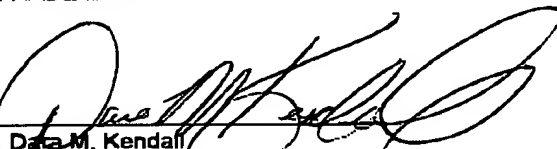
**CONCLUSION**

Based on the foregoing statements, Applicants respectfully submit that the Office has not made prima facie cases of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully submitted,

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May 29, 2002  
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**MARKED VERSION SHOWING CHANGES MADE****IN THE CLAIMS**

Please amend the claims as follows.

4. (Amended) A method according to [any of the preceding claims] claim 1 wherein the weight ratio of insulating external phase to conductive internal phase is about 0.2:1 to 8:1.
5. (Amended) A method according to [any of the preceding claims] claim 1 wherein the insulating external phase has a viscosity of about 10,000 cSt or less.
6. (Amended) A method according to [any of the preceding claims] claim 1 wherein the insulating material of the external phase is selected from the group consisting of volatile silicones, volatile hydrocarbons, and mixtures thereof.
17. (Amended) A method according to [any of the preceding claims] claim 1 wherein the composition comprises about 35 weight % or less solids.
18. (Amended) A method according to [any of the preceding claims] claim 1 wherein the composition comprises one or more ingredients selected from the group consisting of materials which impart film forming or substantive properties, powders, skin feel ingredients, emulsifiers, and structuring or thickening agents.
19. (Amended) A method according to [any of the preceding claims] claim 1 wherein the composition is a cosmetic foundation.
20. (Amended) A method according to [any of the preceding claims] claim 1 wherein the composition is electrostatically sprayed at a flow rate of from about 0.1 to about 100 ml/hr, a voltage of from about 1kV to about 20kV, and an application rate of from about 0.01 mg composition /cm<sup>2</sup> skin to about 12 mg composition /cm<sup>2</sup> skin.